



# UNITED STATES PATENT AND TRADEMARK OFFICE 44

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,910	06/08/2005	Hyo-Soon Shin	110989-05069441	6702
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MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006				
			EXAMINER CHIN, RANDALL E	
			ART UNIT 1744	PAPER NUMBER

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/537,910

Applicant(s)

SHIN, HYO-SOON

Examiner

Randall Chin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

***Drawings***

1. **Figures 4 and 5** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. **Please note, no drawing corrections and Replacement Sheets have been submitted.**

***Claim Objections***

2. Claim 1 is objected to because of the following informalities:  
Claim 1, line 2, "pluarality" should read --plurality--.  
Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The added limitation in claim 1, lines 8-9, reciting “and wherein the brush is not distorted when the brush is inserted into the fixing portion” is not originally supported by the original disclosure and therefore constitutes new matter. Note, the specification at p. 1, lines 12-14 and p. 9, lines 3-8 fails to **explicitly and specifically** provide support for this added limitation. The specification at p. 1, lines 12-14 merely refers to preventing distortion of the brush shape when inserted and withdrawn from a **container**. Also, the specification at p. 9, lines 3-8 merely refers to preventing distortion of the **bristles** when the applicator is inserted and withdrawn from the **container**.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Gueret 6,076,531 (hereinafter Gueret '531).

The patent to Gueret '531 discloses a cosmetic applicator 2 (Fig. 1), comprising a brush consisting of a plurality of bristles 5, a fixing portion (at the end of element 6 in Fig. 1) with a cavity or "hole" formed at one end of the fixing portion so that the brush is inserted into the "hole", and a "rod" 6 coupled to the fixing portion to support the fixing portion, wherein the fixing portion is made of a plastic material (col. 5, lines 36-37) and deemed to be flat, thereby securing the brush inserted into the hole in a flattened shape. Note, the brush in Fig. 1 is in a "flattened shape" when extending out of the fixing portion. Figs. 10 and 11 also show brushes in a somewhat "flattened shape." Note also, the recitation "through a pressing process" is of no patentable significance since such a recitation is drawn to a method step not germane to patentability in apparatus claims.

The added limitation in claim 1, lines 8-9, reciting "and wherein the brush is not distorted when the brush is inserted into the fixing portion" constitutes new matter as explained above. In any case, such recitation referring to the brush not being distorted when the brush is inserted into the "**fixing portion**" appears to be drawn to a **method step** not germane to patentability in apparatus claims.

As for claim 2, the rod 6 is made of plastic synthetic resin, and the fixing portion is formed integrally with the rod (col. 5, lines 36-37).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korea 288433.

Korea 288433 discloses a cosmetic applicator (Fig. 2), comprising a brush consisting of a plurality of bristles 20, a “fixing portion” (merely the **distal tip** portion of element 21 in Fig. 2) with a hole formed at one end of the fixing portion so that the brush is inserted into the hole, and a “rod” 21 coupled to the fixing portion to support the fixing portion, wherein the fixing is deemed to be flat (Fig. 2), thereby securing the brush inserted into the hole in a flattened shape. Note, the brush is in a “flattened shape” at least when extending out of the fixing portion. Note also, the recitation “through a pressing process” is of no patentable significance since such a recitation is drawn to a method step not germane to patentability in apparatus claims. As for the “fixing portion” being made of a plastic material, such a modification (if not already) would be obvious to provide for in order to enable mass production of the device and to make the product lighter in weight.

The added limitation in claim 1, lines 8-9, reciting “and wherein the brush is not distorted when the brush is inserted into the fixing portion” constitutes new matter as explained above. In any case, such recitation referring to the brush not being distorted when the brush is inserted into the “**fixing portion**” appears to be drawn to a **method step** not germane to patentability in apparatus claims.

As for claim 2, it would have been obvious to make the rod 21 of plastic synthetic resin (if not already) in order to mass produce the device and make it lighter in weight. Also, the fixing portion is formed integrally with the rod.

### ***Conclusion***

9. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

The added limitation to claim 1 has been deemed to be adequately addressed by the above rejections.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

1. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Randall Chin', with a long horizontal flourish extending to the right.

Randall Chin  
Primary Examiner  
Art Unit 1744